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09/765,703	01/22/2001	Waifong Liew Anton	Rev 96-3B	2009

7590

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EXAMINER

WANG, SHENGJUN

ART UNIT

PAPER NUMBER

i617

DATE MAILED: 07/29/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/765,703

Applicant(s)

ANTON ET AL.

Examiner

Shengjun Wang

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-- Th MAILING DATE f this c mmunication appears on the c ver she t with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 41-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Pri rity under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Receipt of applicants' amendments and remarks submitted May 16, 2003 is acknowledged.

#### ***Claim Rejections 35 U.S.C. 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 44 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 44 and 45 recite "the polymer" in claim 41, however, claim 41 cites two polymers: "uncrosslinked synthetic polymer having Tg of 76 to 120 °C" and "second shine enhancing " polymer. The claim is indefinite as to which polymer is referred to.

4. Claim 44 and 45 recite "the polymer" but give the name of a monomer.

#### ***Claim Rejections 35 U.S.C. 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 41-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castrogiovanni et al. (US 5,505,937, of record) in view of Mercado et al. (U.S. 4,996,044), Papantoniou et al. (3,911,105), Jacks et al. (U.S. 5,690,918), Mausner (US 5,352,441), and in

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further view of Kumar (US 5,468,477) with respect to claim 45, and Calello (US 6,143,283) to claim 57.

3. Castrogiovanni et al. et al. teaches a lipstick comprising a polymer, volatile oil, non-volatile oil, particulate pigment, wax employed herein and other ingredients well-known for lipstick, such as wax, isododecane, lanolin oil, dimethylsilicone, cyclomethicone, trioctyldodecyl citrate, etc. See the entire document, particularly, the examples, and the claims. Note the lipstick may also contain polymethacrylate or polyacrylate. See column 3, lines 25-26

4. The primary reference does not teach expressly the employment of the methacrylate polymers herein, or the vinylpyrrolidone copolymers, or fluorinated oil.

5. However, Papantoniou et al. teaches that poly methacrylate is known to be useful in lipstick composition for its film forming properties with other well-known ingredients such as silicone wax, lanolin oil etc. See, particularly, the abstract, column 1, lines 48 bridging to column 3, line 16; and example 18. The employment of such polymer renders the lipstick better quality than those without using polymer. See, column 1, lines 25-47. Mercado et al. teaches expressly the usefulness of polyacrylate polymer in lipstick formulation. See, particularly, column 3, lines 1-60, and example 18. Further, copolymers of vinylpyrrolidone are particularly known as film former in lipstick. See, particularly, the abstract, column 5, line 66 bridging column 6, line 10 in Jacks et al., the claims in Mausner.

6. Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to modify the lipstick composition of Castrogiovanni et al. by using the combination of acrylate polymer and vinylpyrrolidone copolymer.

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A person of ordinary skill in the art would have been motivated to modify the lipstick composition of Castrogiovanni et al. using the combination of acrylate polymer and vinylpyrrolidone copolymer because methyl methacrylate polymer and vinylpyrrolidone copolymers are known to be useful in lipstick composition. Note it is prima facie obvious to combine two compositions each of which is taught in the prior art to be useful for same purpose in order to form third composition that is to be used for very the same purpose; idea of combining them flows logically from their having been individually taught in prior art; thus, the claimed invention which is a combination of two known film forming polymer known to be useful in lipstick sets forth prima facie obvious subject matter. See In re Kerkhoven, 205 USPQ 1069. The optimization of the percentage of each known ingredient in a cosmetic composition is considered within the skill of artisan, absent evidence to the contrary.

Claim 45 is rejected for reasons set forth above in further view of Kumar et al. Kumar et al. that isobornyl methacrylate is known to be similarly useful as methyl methacrylate as they polymerize to form polymers with similar glass transition temperature. See column 15, line 10 bridging column 16, line 11, particularly, column 16, lines 9-11. The employment of the particular polymethacrylate is seen to be a selection from amongst equally suitable material and as such obvious. Ex parte Winters 11 USPQ 2<sup>nd</sup> 1387 (at 1388).

Claim 57 is rejected for reasons set forth above in further view of Calello, Calello et al. teaches that fluorinated oil are known to be useful as non-volatile oil in lipstick composition. See, particularly, col. 6, lines 36-49 and the claims. The employment of the particular nonvolatile

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oil is seen to be a selection from amongst equally suitable material and as such obvious. Ex parte Winters 11 USPQ 2<sup>nd</sup> 1387 (at 1388).

***Response to the Arguments***

Applicants' amendments and remarks submitted May 16, 2003 have been fully considered, but are not persuasive for reasons discussed below.

7. Applicants argue that Mercado teaches the polymethacrylate with molecular weight of 100,000 to 1,000,000, and the recommended molecular weight in the claimed composition, which has Tg of 76-120°C, and therefore, the cited reference teaches a different polymer. The examiner disagrees. It is noted that the features upon which applicant relies (i.e., molecular weight) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, it is well-known in the art that the Tg is more related to the structure of monomer and the regularity of the polymer chain rather than to the molecular weight. See, page 4-5 in the specification. Mercado teaches the same polymers herein, and they are reasonably expected to have the similar Tg as herein claimed.

8. Applicants argue that the cited references teaches vinylpyrrolidone polymer as high viscosity oil soluble liquids, while the claimed invention require Tg 76-120 °C. The arguments are improper. First, applicants erred in citing Tg 76-120 °C as a limitation of shine enhancing polymer, which is incorrect. See claim 1 herein; second, PVP copolymers as herein employed are well-known film forming polymers (Mausner), which are known to be useful in lipstick composition.

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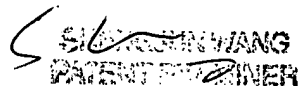
9. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Examiner

  
PATENT EXAMINER

Shengjun Wang

July 24, 2003